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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,108	03/29/2001	Maria A. Himmel	AUS8-2001-0188-US1	3261

7590 10/23/2003

Frank C. Nicholas  
CARDINAL LAW GROUP  
Suite 2000  
1603 Orrington Avenue  
Evanston, IL 60201

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,108

Applicant(s)

HIMMEL ET AL.

Examiner

Jean D Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandera, US Patent 6,332,127.

The applied reference has a common Assignee (IBM) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As per claims 1, 8 and 15, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 25 to a user or customer using a portable terminal or

Art Unit: 3622

mobile web client 21 of fig. 2, having a display or screen, an input device and so forth, connected to the communication means 25 wherein advertising object 32 and other information 34 are returned to the user via a web page 26 in response to the accessing a web site by the user for information (user inputting a keyword or a request for information via mobile station 21) and wherein an object oriented programming language such as JAVA (software) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. In other words, a targeted advertisement is returned to the user along with the requested information based on the location of the user's mobile station, the time of the day, the location of the advertiser and on the content of the requested information. (See abstract; figs. 1-2 and 6; col.1: 66 to col. 2: 10; col. 2: 33 to col. 3: 41; col. 9: 26 to col. 6: 24; col. 9: 29-41).

Furthermore, Bandera et al. disclose a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 2 to a user or customer using a portable terminal or mobile web client 21 of fig. 2 and wherein the JVM installed on the portable terminal or mobile web client allows the user of the portable device or terminal to access information object **such as entertainment** on a web site having a web server 24 of fig. 2 running a JAVA enabled browser, thereby allowing the user of the portable device to receive text, audio and video messages (fig. 2; col. 5: 36-61).

Art Unit: 3622

As per claims 2-7, 9-14 and 16-21, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 25 to a user or customer using a portable terminal or mobile web client 21 of fig. 2, having a display or screen, an input device and so forth, connected to the communication means 25 wherein advertising object 32 and other information 34 are returned to the user via a web page 26 in response to the accessing a web site by the user for information (user inputting a keyword or a request for information via mobile station 21) and wherein an object oriented programming language such as JAVA (software) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. In other words, a targeted advertisement is returned to the user along with the requested information based on the location of the user's mobile station, the time of the day, the location of the advertiser and on the content of the requested information. (See abstract; figs. 1-9B; col.1: 66 to col. 2: 10; col. 2: 33 to col. 3: 41; col. 9: 26 to col. 6: 24; col. 9: 29-41).

Furthermore, Bandera et al. disclose a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 2 to a user or customer using a portable terminal or mobile web client 21 of fig. 2 and wherein the JVM installed on the portable terminal or mobile web client allows the user of the portable device or terminal to access information object **such as entertainment** on a web site having a web server 24 of fig. 2 running a JAVA enabled browser,

Art Unit: 3622

thereby allowing the user of the portable device to receive text, audio and video messages (fig. 1; col. 5: 36-61). In addition, a user actuating the validation anchor link 36 of fig. 4 to retrieve the coupon associated with the targeted displayed advertisement or product advertisement confirms that the user has indeed been exposed to the advertisement (verifying that the user reads the advertisement-fig. 5).

### **Conclusion**

Although the following references were not officially used in the Office Action, they were highly considered.

US Patent 6, 487, 538B1 to Gupta discloses an advertising negotiating system wherein advertisements are displayed to the user in accordance with the user's profile matching the advertiser's specifications.

US Patent 5, 724,521 to Dedrick discloses an advertising system wherein advertisements are displayed to the user in accordance with the user's profile matching the advertiser's specifications based on best fit profile.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

Art Unit: 3622

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

09/10/03



Jean D. Janvier

Patent Examiner

Art Unit 3622